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RABINOWITZ, BOUDIN, STANDARD, KRINSKY & LIEBERMAN, P.C.  
ATTORNEYS AT LAW  
740 BROADWAY AT ASTOR PLACE  
NEW YORK, N.Y. 10003-9518

# 5

TELEPHONE (212) 254-1111  
CABLE "RABOUDIN, N.Y." TELEX 225028  
FACSIMILE (212) 674-4614

LEONARD B. BOUDIN (1912-1989)  
MICHAEL KRINSKY  
ERIC LIEBERMAN  
HILLARY RICHARD

THOMAS C. VILES  
LAURIE EDELSTEIN\*  
CAROLINE RULE  
MICHAEL LUDWIG  
LAURENCE HELFER<sup>2</sup>

\* ADMITTED IN CALIFORNIA ONLY  
<sup>2</sup> ADMITTED IN PENNSYLVANIA AND  
NEW JERSEY ONLY

COUNSEL  
VICTOR RABINOWITZ  
MICHAEL B. STANDARD  
LEONARD I. WEINGLASS  
JOHN MAGE  
ELLEN J. WINNER  
DEBRA EVENSON  
TERRY GROSS

October 27, 1994

BY EXPRESS MAIL, Label No. HB309363131

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Re: Cancellation No. 22,881

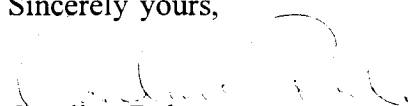
Dear Sir/Madam:

Enclosed please find for filing the original and two copies of the Answer To Petition For Cancellation in the above-referenced cancellation proceeding. A Certificate of Express Mailing and Service is appended to the end of the document. Also enclosed is a check for \$100.00, which I was informed by your office is the required fee for filing an Answer that contains a counterclaim, as this does.

Also enclosed please find the original and two copies of a Motion For Joinder And Substitution Of Party Respondent in the above-referenced cancellation proceeding. A Certificate of Express Mailing and Service is appended to the end of the document.

Thank you for your attention.

Sincerely yours,

  
Caroline Rule

cc: Robert B. Kennedy, Esq.  
Kennedy & Kennedy  
400 Northpark Town Center  
1000 Abernathy Road  
Atlanta, Georgia 3032

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

#15

Jose Ma. Arechabala Rodrigo

Cancellation No. 22,881

OCT 27 1994 v.

Havana Rum and Liquors, S.A.

H.R.L., S.A.

Registration No. 1,031,651

ANSWER TO PETITION FOR CANCELLATION

Havana Club Holding, S.A., the current owner of the trademark identified in the heading of this document, and Havana Rum & Liquors, S.A., the named respondent in this cancellation proceeding, in response to the notice dated July 19, 1994, instituting the instant cancellation proceeding, answer the petition as follows:

1. Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. are without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 1 of the petition, and based thereon deny each and every such averment.

2. Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. admit that Registration No. 1,031,651 includes the words HAVANA CLUB and is for rum, a distilled liquor, but are without knowledge or information sufficient to form a belief as to the truth of the averment that these words are identical to those which petitioner now seeks to register and based thereon deny such averment.

3. Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. deny each and every averment of paragraph 3 of the petition.

4. Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. are without knowledge or information sufficient to form a belief as to the truth of paragraph 4 of the petition, and based thereon deny each and every such averment, other than to admit that petitioner's application for registration of the trademark HAVANA CLUB should be rejected.

IN FURTHER ANSWER TO THE PETITION, and without admitting or conceding that it is necessary to assert such defenses as affirmative defenses, and without any admission as to the burden of proof or persuasion with respect to such matters, Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. allege that:

FIRST AFFIRMATIVE DEFENSE TO PETITION FOR CANCELLATION

5. Petitioner has failed to allege grounds sufficient to establish his standing to maintain the present petition for cancellation.

6. Petitioner does not have standing to bring this petition for cancellation.

7. Petitioner is not damaged by the existence of Registration No. 1,031,651 because petitioner is not entitled to registration of the trademark HAVANA CLUB in the United States for reasons apart from the existence of Registration No. 1,031,651.

8. The primary significance of the term "Havana" is geographic inasmuch as Havana is the capital of Cuba and its leading city. The public is likely to believe that goods sold under a trademark including that term originate from Cuba. Furthermore, the long history of consumption of rum of Cuban origin in the United States, the fact that rum of Cuban origin is famous in the United States, and the fact that a particular rum of Cuban origin, sold under the trademark HAVANA CLUB, is known in the United States, would materially influence consumers to purchase distilled liquor marketed under this mark in the

belief that such liquor originated in Cuba. Indeed, the United States Patent and Trademark Office has so ruled in refusing another application, serial no. 74/448589, made by a United States person to register the trademark HAVANA CLUB for use in connection with rum. A true and accurate copy of a written office action in response to application no. 74/448589 is attached hereto.

9. Havana Club Holding, S.A., has granted to Havana Club International, S.A., a company organized under Cuban law with its principal offices in Havana, Cuba, an exclusive license to use the trademark HAVANA CLUB in connection with its export of HAVANA CLUB rum throughout the world. Havana Club International, S.A., therefore has the exclusive right and the potential to export HAVANA CLUB rum from Cuba to the United States under the trademark HAVANA CLUB. Petitioner, in contrast, does not have the right or potential to export HAVANA CLUB or other rum of Cuban origin to the United States.

10. The trademark HAVANA CLUB would be geographically misdescriptive and deceptive if registered or used by Petitioner and, consequently, Petitioner would not be entitled to registration of the trademark HAVANA CLUB or to use the trademark HAVANA CLUB in the United States even if the mark was not currently registered in the United States. Petitioner is thus not damaged by the existence of Registration No. 1,031,651.

#### SECOND AFFIRMATIVE DEFENSE TO PETITION FOR CANCELLATION

Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. repeat and reallege the allegations of paragraphs 5 through 10 of this Answer To Petition For Cancellation and, in further answer to the petition, state:

11. Petitioner has failed to allege grounds sufficient to establish his standing to maintain the present petition for cancellation.

12. Petitioner does not have standing to bring this petition for cancellation.

13. Petitioner is not damaged by the existence of Registration No. 1,031,651.

14. HAVANA CLUB rum is known in the principal rum-consuming markets of the world, including in the United States, as a high-quality rum of Cuban origin. Advertisements for the rum have appeared in publications that are available in the United States, the rum has been discussed in articles in United States publications, and the rum was featured by name in a major motion picture, "The Firm," that was distributed throughout the United States and seen by over ten million people in the United States.

15. Petitioner could not adopt use of the trademark HAVANA CLUB in the United States in good faith, because HAVANA CLUB rum is well-known in the United States. The mark HAVANA CLUB, as used in foreign countries, including Spain where Petitioner resides, is famous within the United States. Consequently, because Petitioner could not use the mark HAVANA CLUB in good faith, he is not damaged by the existence of Registration No. 1,031,651.

16. Any use by petitioner of the trademark HAVANA CLUB in commerce in the United States would be confusing to consumers familiar with HAVANA CLUB rum, and consequently Petitioner would not be entitled to registration of the mark HAVANA CLUB in the United States even if it were not already registered. Consequently, Petitioner is not damaged by the existence of Registration No. 1,031,651.

### THIRD AFFIRMATIVE DEFENSE TO PETITION FOR CANCELLATION

Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. repeat and reallege the allegations of paragraphs 5 through 16 of this Answer To Petition For Cancellation, and, in further answer to the petition, state:

17. HAVANA CLUB is the tradename of a rum produced in Cuba, which is sold throughout the world under that trademark.

18. The trademark HAVANA CLUB was registered in the United States Patent and Trademark Office on January 27, 1976 by Empresa Cubana Exportadora De Alimentos y Productos Varios, a Cuban company that is known by the acronym "Cubaexport." Cubaexport, which had the exclusive right to export HAVANA CLUB rum from Cuba and developed an international export business for HAVANA CLUB rum, owned the Cuban registration of the trademark HAVANA CLUB, registered in Cuba on February 12, 1974. Cubaexport applied for and was granted registration of the trademark in the United States on the basis of that foreign registration, pursuant to Section 44 of the Lanham Act, 15 U.S.C. § 1126a.

19. Cubaexport filed an affidavit under Section 8 of the Lanham Act in the United States Patent and Trademark Office on January 13, 1982. The affidavit was accepted by the United States Patent and Trademark Office on March 22, 1982.

20. In or about 1993, Cubaexport transferred its entire business connected with HAVANA CLUB rum, including the goodwill associated with that business worldwide, the right to export HAVANA CLUB rum to all the territories of the world, and all its other rights, titles and interests associated with HAVANA CLUB rum to Havana Rum & Liquors,

S.A., a company organized under the laws of Cuba with its principal offices in Havana, Cuba, which specializes in the liquor business. Along with and as part of this transfer of its HAVANA CLUB rum business, Cubaexport assigned its trademark HAVANA CLUB, together with the goodwill of the business symbolized by that mark as registered and used around the world, to Havana Rum & Liquors, S.A. Accordingly, on January 10, 1994, Cubaexport executed a written assignment of the trademark HAVANA CLUB as registered in the United States, along with the goodwill of the business symbolized by that trademark, to Havana Rum & Liquors, S.A. This assignment was recorded in the United States Patent and Trademark Office on February 10, 1994, and is found in Reel 1104, Frame 0046.

21. Havana Rum & Liquors, S.A. in turn assigned the worldwide rights to the trademark HAVANA CLUB, along with the goodwill of the business symbolized by the mark, including the mark as registered in the United States, to Havana Club Holding, S.A., a company organized under the laws of Luxembourg, in which Havana Rum & Liquors, S.A. is a shareholder. On June 22, 1994, Havana Rum & Liquors, S.A., executed a written assignment of the trademark HAVANA CLUB, as registered in the United States, along with the goodwill of the business symbolized by that trademark, to Havana Club Holding, S.A. The assignment was submitted to the United States Patent and Trademark Office for recording on September 7, 1994.

22. Regulations issued by the United States Department of the Treasury, the Cuban Assets Control Regulations, 31 C.F.R. Part 515, promulgated pursuant to the Trading With the Enemy Act, 50 U.S.C. App. 5(b), forbid the importation into the United States of merchandise from Cuba or merchandise that is of Cuban origin, 31 C.F.R. §§ 515.201 &

515.204, or the use in the commerce of the United States of any trademark in which Cuba or a Cuban national has, or had at any time since 1963, any interest of any nature whatsoever, direct or indirect, *id.* §§ 515.201 & 515.311. These United States prohibitions against imports of merchandise from Cuba or of Cuban origin, and against the use of a trademark in which a Cuban national has an interest, have been in effect since 1963.

23. The filing and registration in the United States Patent and Trademark Office of trademarks in which Cuba or Cuban nationals have, or at any time since 1963 had, an interest is permitted under the United States trade regulations. 31 C.F.R. § 515.527.

24. The legal impossibility of the aforementioned successive owners and licensee of the HAVANA CLUB business and trademark exporting HAVANA CLUB rum to the United States, and the legal impossibility of their using the trademark HAVANA CLUB in commerce in the United States in connection therewith, excuses such non-use of the trademark in commerce in the United States.

#### FOURTH AFFIRMATIVE DEFENSE TO PETITION FOR CANCELLATION

Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. repeat and reallege the allegations of paragraphs 5 through 24 of this Answer To Petition For Cancellation and, in further answer to the petition, state:

25. Cubaexport, the Cuban enterprise that originally registered the trademark HAVANA CLUB in the United States in 1976, also registered the trademark HAVANA CLUB in at least twenty other countries around the world including Germany, the United Kingdom, Andorra, various countries in Central America, Mexico, Austria, Spain, Italy,



Sweden, France, Denmark, Finland, the Canary Islands, Canada, Chile, Peru, Bolivia, Hungary and Argentina.

26. HAVANA CLUB rum is the premier rum produced in Cuba, and it is produced predominantly for export purposes.

27. The high quality of HAVANA CLUB rum, and the efforts of Cubaexport to promote exports of the rum, resulted in the export of over 20 million cases (9 liters each) of HAVANA CLUB rum in the years 1975-1993.

28. In 1993, Cubaexport exported HAVANA CLUB rum from Cuba under the HAVANA CLUB trademark to over twenty countries including Germany, the United Kingdom, Andorra, the countries of Central America, Mexico, Austria, Spain, Italy, Sweden, France, Denmark, Finland, the Canary Islands, Canada, Chile, Peru, Bolivia, Hungary and Argentina, in all of which countries the HAVANA CLUB business has built up substantial goodwill. HAVANA CLUB rum was widely advertised under the HAVANA CLUB trademark in major newspapers and magazines in these countries.

29. In or about 1993, Cubaexport transferred its entire business connected with HAVANA CLUB rum, including the goodwill associated with that business worldwide, the right to export HAVANA CLUB rum to all the territories of the world, and all its other rights, titles and interests associated with HAVANA CLUB rum to Havana Rum & Liquors, S.A., a company organized under the laws of Cuba with its principal offices in Havana, Cuba, which specializes in the liquor business. Along with and as part of this transfer of its HAVANA CLUB rum business, Cubaexport assigned its trademark HAVANA CLUB, together with the goodwill of the business symbolized by that mark as registered and used

around the world, to Havana Rum & Liquors, S.A. Accordingly, on January 10, 1994, Cubaexport executed a written assignment of the trademark HAVANA CLUB as registered in the United States, along with the goodwill of the business symbolized by that trademark, to Havana Rum & Liquors, S.A. This assignment was recorded in the United States Patent and Trademark Office on February 10, 1994, and is found in Reel 1104, Frame 0046.

30. Havana Rum & Liquors, S.A. in turn assigned the worldwide rights to the trademark HAVANA CLUB, along with the goodwill of the business symbolized by the mark, including the mark as registered in the United States, to Havana Club Holding, S.A., a company organized under the laws of Luxembourg, in which Havana Rum & Liquors, S.A. is a shareholder. On June 22, 1994, Havana Rum & Liquors, S.A., executed a written assignment of the trademark HAVANA CLUB, as registered in the United States, along with the goodwill of the business symbolized by that trademark, to Havana Club Holding, S.A. The assignment was submitted to the United States Patent and Trademark Office for recording on September 7, 1994.

31. Havana Club Holding, S.A. is thus the current owner of trademark registrations for HAVANA CLUB in over twenty countries around the world, including in the United States.

32. Havana Club Holding, S.A., the owner of the trademark HAVANA CLUB in the United States and elsewhere, has granted to Havana Club International, S.A., a Cuban company, the exclusive license to use the trademark HAVANA CLUB worldwide, including in the United States, along with the goodwill of the business symbolized by the mark worldwide, in connection with its sale of HAVANA CLUB rum. Similarly, and in

keeping with its license for the worldwide use of the trademark HAVANA CLUB, Havana Club International, S.A. has been granted the exclusive right to export and market HAVANA CLUB rum worldwide, including in the United States.

33. Pernod Ricard, S.A., a manufacturer and international distributor of liquors, headquartered in Paris, France, is associated with Havana Club Holding, S.A. and Havana Club International, S.A.

34. Historically, the United States has been an important and lucrative market for Cuban rum.

35. Since 1963, the Cuban Assets Control Regulations, 31 C.F.R. Part 515 have prohibited the importation of merchandise of Cuban origin into the United States, 31 C.F.R. §§ 515.201 & 515.204, or the use in the commerce of the United States of any trademark in which Cuba or a Cuban national has, or had at any time since 1963, an interest, *id.* §§ 515.201 & 515.311. The regulations have, however, have permitted the registration in the United States Patent and Trademark Office of trademarks in which Cuba or Cuban nationals have, or at any time since 1963 had, an interest. 31 C.F.R. § 515.527.

36. At the time of the 1976 registration of the trademark HAVANA CLUB in the United States, and until its assignment of the worldwide rights to the trademark HAVANA CLUB, along with the goodwill of the business symbolized by the HAVANA CLUB mark, to Havana Rum and Liquors, S.A., Cubaexport intended to export HAVANA CLUB rum to the United States as soon as the importation of Cuban products into the United States was permitted by United States law, and to use the trademark HAVANA CLUB in commerce in the United States in connection therewith.

37. In keeping with Cubaexport's intention of exporting HAVANA CLUB rum to the United States under the HAVANA CLUB trademark as soon as it was permitted to do so by United States law, the Ministry of Foreign Trade of the Republic of Cuba, which has the responsibility of establishing the foreign trade policy of Cuba, and which had the objective of expanding markets for Cuban products, held discussions with representatives of United States companies, who expressed interest in future importation of rum from Cuba, and in particular the future importation of HAVANA CLUB rum, should the trade sanctions be lifted.

38. At the time of the 1976 registration of the trademark HAVANA CLUB in the United States, and until its assignment of the trademark HAVANA CLUB to Havana Rum and Liquors, S.A. along with the transfer of the worldwide business associated with HAVANA CLUB rum, Cubaexport considered the United States to be potentially one of the most profitable markets for HAVANA CLUB rum, because, amongst other reasons, the United States has a high rate of rum consumption, and because the proximity of the United States market to Cuba would minimize freight costs.

39. At the time that it acquired the worldwide business associated with Havana Club rum, along with the trademark HAVANA CLUB as registered around the world, including in the United States, and until its transfer of the HAVANA CLUB trademark, along with the goodwill of the business symbolized by that mark, to Havana Club Holding, S.A., Havana Rum & Liquors, S.A. intended to export HAVANA CLUB rum to the United States, and to use the trademark HAVANA CLUB in commerce in the United States in connection therewith as soon as United States law permitted.

40. At the time that it was assigned the trademark HAVANA CLUB as registered and used worldwide, along with the goodwill of the business associated with that mark, and at the time that it licensed Havana Club International, S.A. to use the trademark HAVANA CLUB, and at all times since then, Havana Club Holding, S.A. has intended to export, through its exclusive licensee Havana Club International, S.A., HAVANA CLUB rum to the United States, and to use the trademark HAVANA CLUB in commerce in the United States in connection therewith, as soon as it is permitted to do so by United States law. At all times since it was licensed to use the trademark HAVANA CLUB throughout the territories of the world, including the United States, Havana Club International, S.A. has intended to export HAVANA CLUB rum to the United States, and to use the trademark HAVANA CLUB in commerce in the United States in connection therewith, as soon as the importation of Cuban products into the United States, and the use in the United States of a trademark in which a Cuban national has any interest, is permitted by United States law.

41. Since Havana Club International, S.A. acquired the exclusive right to export HAVANA CLUB rum from Cuba and to use the trademark HAVANA CLUB worldwide in connection therewith, it has continued to export HAVANA CLUB rum from Cuba under the trademark HAVANA CLUB to over twenty countries without interruption. There has been no interruption in exports of HAVANA CLUB rum under the HAVANA CLUB trademark from Cuba since Cubaexport ceased exporting the rum and Havana Club International, S.A. took over the worldwide distribution of the rum. Havana Club International, S.A. has also planned to increase exports of HAVANA CLUB rum under the

HAVANA CLUB trademark to existing markets, as well as to expand such exports into new markets.

42. Havana Club International, S.A. intends to export HAVANA CLUB rum to the United States, and to use the HAVANA CLUB trademark in commerce in the United States in connection therewith, as soon as United States law permits. To that end, the territory of the United States was included in the worldwide license for the distribution of HAVANA CLUB rum and for the use of the trademark HAVANA CLUB in connection therewith granted to Havana Club International, S.A. by Havana Club Holding, S.A.

43. Since 1976, the United States has been a natural and potentially one of the most profitable markets for HAVANA CLUB rum, and has been believed to be so by Cubaexport, Havana Rum & Liquors, S.A., Havana Club Holding, S.A., and Havana Club International, S.A., for reasons including the following: the United States has the largest and wealthiest consumer population of all the countries in proximity to Cuba; rum has been popular in the United States for decades; freight costs to the United States would be far lower than freight costs to other current markets for HAVANA CLUB rum; large scale tourism from the United States to Cuba, which existed before the sanctions against Cuba were instituted, and which is certain to resume once the sanctions are lifted, will serve to acquaint the United States consumer with Cuban products, including HAVANA CLUB rum; and there is no major producer of rum in the United States which would enjoy a competitive advantage through closer market proximity.

44. In keeping with its view of the United States as the natural market for HAVANA CLUB rum, Havana Club International, S.A. has analyzed the potential of the

United States market for HAVANA CLUB rum, and the best methods for distributing and marketing the product in the United States under the trademark HAVANA CLUB.

45. Since the 1976 registration of the trademark HAVANA CLUB in the United States, neither the current owner, Havana Club Holding, S.A., nor either of the prior owners, Havana Rum & Liquors, S.A., or Cubaexport, has ever had any intention of abandoning the trademark HAVANA CLUB in the United States. At all times since the 1976 registration of this mark, the current owner, that owner's assignor, and the prior assignor have all in turn fully intended to, and have planned to, market HAVANA CLUB rum produced in Cuba in the United States, and to use the trademark HAVANA CLUB in commerce in the United States in connection therewith, as soon as United States law permits.

46. In keeping with the intent to use the trademark HAVANA CLUB in commerce in the United States as soon as United States law permitted them to export HAVANA CLUB rum to the United States, Cubaexport and its successive assignees of the mark and the goodwill associated with the mark maintained the registration of the mark in the United States, and assigned the registration, including the goodwill of the business symbolized by that mark, or licensed the right to use the mark, to the successive entities that have controlled the business associated with HAVANA CLUB rum and that consequently have had the right and ability to export HAVANA CLUB rum to the United States.

47. The sole and exclusive reason why Havana Club Holding, S.A., Havana Club International, S.A., Havana Rum & Liquors, S.A., and Cubaexport have not sold HAVANA CLUB rum in the United States, and consequently have not used the registered

trademark HAVANA CLUB in commerce in the United States, is that they have been forbidden to do so by the United States Department of the Treasury's Cuban Assets Control Regulations.

48. The legal impossibility of exporting HAVANA CLUB rum to the United States experienced by the owners of the trademark HAVANA CLUB and the goodwill of the business associated with that mark, both internationally and in the United States, and their resulting inability to use the trademark HAVANA CLUB in commerce in the United States, excuses such non-use of the trademark in commerce in the United States.

49. The legal impossibility of Havana Club Holding, S.A., its licensee, and the prior owners of the HAVANA CLUB trademark exporting HAVANA CLUB rum to the United States and using the trademark HAVANA CLUB in commerce in the United States in connection therewith, together with their intention and plans to export HAVANA CLUB rum to the United States and to use the trademark in commerce in the United States in connection therewith as soon as it becomes possible to do so, rebuts any inference that the trademark HAVANA CLUB has been abandoned in the United States.

#### COUNTERCLAIM

In further response to the petition, Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. assert the following counterclaim:

50. Havana Club Holding, S.A., owner of Registration No. 1,031,651 of the trademark HAVANA CLUB in International Class 33, and Havana Rum & Liquors, S.A., named as respondent in the caption of this cancellation proceeding, oppose Petitioner's application, serial no. 74/522925, for registration of the mark HAVANA CLUB in



International Class 33. Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. believe that they will be damaged by registration of the mark HAVANA CLUB as shown in the Petitioner's application, serial no. 74/522925, and hereby oppose the same.

51. The allegations of paragraphs 5 through 49 of this Answer To Petition For Cancellation are incorporated herein by this reference.

52. Any registration of the mark HAVANA CLUB in International Class 33 in Petitioner's name would be confusingly similar to Havana Club Holding, S.A.'s mark in the same class.

53. Registration of the mark HAVANA CLUB in Petitioner's name would be geographically misdescriptive and deceptive in that Petitioner cannot use the mark in connection with the sale of Cuban rum, while consumers would believe that a liquor bearing the name HAVANA CLUB originated in Cuba, and would be materially influenced by that belief to purchase such liquor.

54. Petitioner's application for registration of the mark HAVANA CLUB is not made in good faith because HAVANA CLUB rum is well-known in the United States, and thus the mark HAVANA CLUB as used in foreign countries, including Spain where Petitioner resides, is famous within the United States. Havana Club Holding, S.A. thus has priority in the use of the trademark HAVANA CLUB within the United States, apart from its ownership of the registration of the mark in the United States.

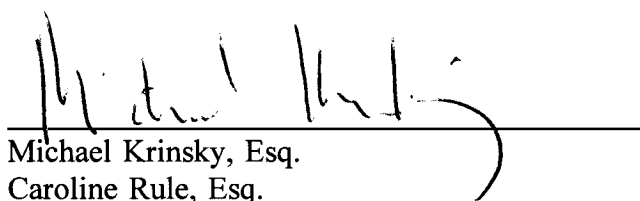
55. Consumers would be confused by any use by Petitioner of the trademark HAVANA CLUB in the United States, because HAVANA CLUB rum is well known in the United States. Consequently, Petitioner is not entitled to registration of the trademark HAVANA CLUB.

RELIEF REQUESTED

WHEREFORE

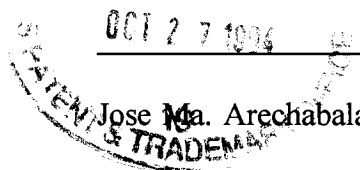
1. Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. ask that this cancellation proceeding be dismissed.
2. For the counter-claim, Havana Club Holding, S.A. and Havana Rum & Liquors, S.A. ask that Petitioner's application, serial no. 74/522925, for registration of the mark HAVANA CLUB in International Class 33 be refused.

Respectfully submitted,



Michael Krinsky, Esq.  
Caroline Rule, Esq.  
RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.  
740 Broadway - Fifth Floor  
New York, New York 10003  
(212) 254-1111  
Attorneys for Havana Club Holding, S.A. and  
Havana Rum & Liquors, S.A.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**



\_\_\_\_\_  
Jose Ma. Arechabala Rodrigo )

Cancellation No. 22,881

v. )

Havana Rum and Liquors, S.A. )  
DBA H.R.L., S.A. )

Registration No. 1,031,651 )  
\_\_\_\_\_)

**NOTICE OF MOTION FOR JOINDER AND SUBSTITUTION OF PARTY RESPONDENT**

To Jose Ma. Arechabala Rodrigo and his Attorney of Record:

PLEASE TAKE NOTICE that Havana Club Holding, S.A., and Havana Rum & Liquors, S.A., by this document and upon the attached Affidavit of Caroline Rule, Esq., and pursuant to 37 C.F.R. §§ 2.127 & 2.113 and Rules 19 and 25 of the Federal Rules of Civil Procedure, moves the Trademark Trial and Appeals Board for an Order joining Havana Club Holding, S.A. as a respondent in the above-captioned cancellation proceeding until such time as an assignment of trademark Registration No. 1,031,651 from Havana Rum & Liquors, S.A., named as respondent in the above-captioned matter, to Havana Club Holding, S.A., is recorded in the Patent and Trademark Office; and thereafter substituting Havana Club Holding, S.A. as the respondent in the above-captioned cancellation proceeding.

## MEMORANDUM OF POINTS AND AUTHORITIES

The present motion is brought pursuant to 37 C.F.R. § 2.113 and Rules 19 and 25 of the Federal Rules of Civil Procedure to join and then to substitute Havana Club Holding, S.A. as the respondent in the above-captioned matter.

This proceeding concerns the trademark Havana Club, registered in International Class 33. This mark, Registration No. 1,031,651, was registered on January 27, 1976 by Empresa Cubana Exportador de Alimentos y Productos Varios (the Cuban Export Enterprise of Food and Various Products), a Cuban company known by the acronym "Cubaexport."

Cubaexport assigned the trademark Havana Club, Registration No. 1,031,651, to Havana Rum & Liquors, S.A., a Cuban company, on January 10, 1994. This assignment was recorded in the Patent and Trademark Office on February 10, 1994, and may be found at Reel 1104, Frame 0046.

On June 22, 1994, Havana Rum & Liquors, S.A. assigned the trademark Havana Club, Registration No. 1,031,651, to Havana Club Holding, S.A., a Luxembourg company, which is the movant herein. This assignment was mailed to the Patent and Trademark Office for recording on September 7, 1994. (See Rule Aff. ¶ 4 and Exhibit A thereto). The assignment has not yet been recorded in the Patent and Trademark Office.

As a result of the as-yet-unrecorded assignment, Havana Club Holding, S.A. is the current owner of the trademark, and consequently should be substituted for Havana Rum & Liquors, S.A. as the respondent in the above-captioned cancellation proceeding. Consequently, Havana Club Holding, S.A. and Havana Rum and Liquors, S.A. jointly move

for Havana Club Holding, S.A. to be so substituted once the assignment of the trademark Havana Club to Havana Club Holding, S.A. is recorded in the Patent and Trademark Office. Until such time as the assignment is recorded, Havana Rum and Liquors, S.A. and Havana Club Holding, S.A. jointly move for Havana Club Holding, S.A. to be joined as a party respondent in the above-captioned cancellation proceeding.

37 C.F.R. § 2.113 provides that the Trademark Trial and Appeals Board may "join or substitute as respondent a party who makes a showing of a current ownership in . . . [a] registration [that is the subject of the proceeding in question]." As Havana Club Holding, S.A. has been the owner of the registration at issue in this proceeding since June 22, 1994 (as demonstrated in the assignment from Havana Rum & Liquors, S.A. (Rule Aff. Exh. A)), it accordingly should be substituted as the respondent in this case once the assignment is officially recorded.

Rule 25 of the Federal Rules of Civil Procedure similarly provides that, when a transfer of interest occurs during the pendency of a case, the court may upon motion "direct[] the person to whom the interest is transferred to be substituted in the action or joined with the original party." Fed. R. Civ. P. 25(c). As the ownership of the registration at issue here has been transferred to Havana Club Holding, S.A., Havana Club Holding should be joined as a respondent in this case, and should be substituted for Havana Rum & Liquors, S.A., which currently appears in the records of the Patent and Trademark Office as the owner of the registration, once the assignment from Havana Rum & Liquors to Havana Club Holding is officially recorded.

Finally, Rule 19 of the Federal Rules of Civil Procedure similarly provides that

a person may be joined in any action where "the person claims an interest relating to the subject of the action and is so situated that the disposition of the action in the person's absence may . . . as a practical matter impair or impede the person's ability to protect that interest." Fed. R. Civ. P. 19(a)(2). As current owner of the registration at issue here, Havana Club Holding, S.A. must be joined in his action and allowed to contest this cancellation proceeding. Should it not be permitted to do so, and should the registration of the Havana Club trademark be cancelled, Havana Club Holding, S.A. will lose its entire interest in the registration without the opportunity to defend that interest.

The petitioner in this cancellation proceeding will not be prejudiced if this motion is granted. Petitioner's only action in this proceeding to date has been to file a petition for cancellation. This petition for cancellation should be directed to the current owner of the trademark sought to be cancelled, and that current owner is Havana Club Holding, S.A.

### CONCLUSION

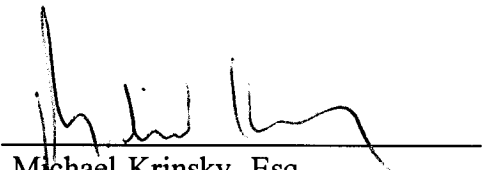
For the foregoing reasons, Havana Rum & Liquors, S.A. and Havana Club Holding, S.A. respectfully request that Havana Club Holding, S.A. be joined as a respondent in the above-captioned matter; and that, upon the recording of the assignment of the ownership of the trademark Registration No. 1,031,651 to Havana Club Holding, S.A., that Havana Club Holding, S.A. be substituted for Havana Rum & Liquors, S.A. as the respondent in this matter.

Dated: New York, New York  
October 27, 1994

Respectfully submitted,

RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.

By:



Michael Krinsky, Esq.

Caroline Rule, Esq.

Attorneys for Movant, Havana Club  
Holding, S.A. and  
Attorneys for Respondent, Havana Rum &  
Liquors, S.A.  
740 Broadway - Fifth Floor  
New York, New York 10003  
(212) 254-1111

To: Robert B. Kennedy, Esq.  
Kennedy & Kennedy  
400 Northpark Town Center  
1000 Abernathy Road, Suite 1250  
Atlanta, GA 30328

Jose Ma. Arechabala Rodrigo	)	Cancellation No. 22,881
	)	
v.	)	
	)	AFFIDAVIT OF
Havana Rum and Liquors, S.A.	)	<u>CAROLINE RULE, ESQ.</u>
DBA H.R.L., S.A.	)	
	)	
Registration No. 1,031,651	)	
	)	

STATE OF NEW YORK     )  
                             )ss.:  
COUNTY OF NEW YORK )

CAROLINE RULE, ESQ., being duly sworn, deposed and says:

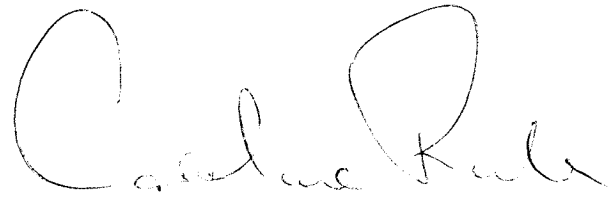
1. I am a member of the bar of the State of New York, and I am associated with the law firm Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., attorneys for the current respondent in the above-captioned cancellation proceeding, Havana Rum & Liquors, S.A.

2. I make this affidavit in support of the joint motion of Havana Club Holding, S.A., a Luxembourg company, and Havana Rum and Liquors, S.A. for Havana Club Holding, S.A. to be joined and substituted as a respondent in this action. Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. also represents Havana Club Holding, S.A.

3. I make this affidavit upon personal knowledge, and upon information and belief based on my review of the file in this case.

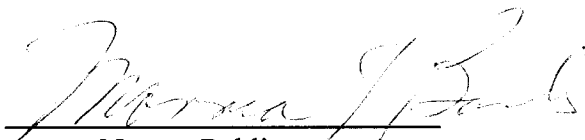


4. On June 22, 1994, Havana Rum & Liquors, S.A., which was then the registered owner of the trademark Havana Club, Registration No. 1,031,651, which is the subject of this cancellation proceeding, executed an assignment of that trademark, along with the goodwill of the business symbolized by the mark, to Havana Club Holding, S.A. The original of the executed assignment was mailed to the Patent and Trademark Office on September 7, 1994 for recording. A true and accurate copy of the documents submitted to the Patent and Trademark Office on that date is attached hereto as Exhibit A.



Caroline Rule, Esq.

Sworn to before me this  
27th Day of October, 1994

  
Notary Public

**MARRIA E. BANKS**  
Notary Public, State of New York  
No. 31-4821564  
Qualified in New York County  
Commission Expires *JUNE* 30, 1996

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

\_\_\_\_\_  
Jose Ma. Arechabala Rodrigo )

Cancellation No. 22,881

v. )

Havana Rum and Liquors, S.A. )  
DBA H.R.L., S.A. )

Registration No. 1,031,651 )  
\_\_\_\_\_)

**CERTIFICATE OF EXPRESS MAILING AND SERVICE**

I, Caroline Rule, Esq., hereby certify that the attached Motion For Joinder And Substitution Of Party Respondent in the above-captioned cancellation proceeding is being deposited today, October 27, 1994, with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service, in an envelope addressed to to the following:

- 1) mailing label No. HB309363131, addressed to:

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

- 2) mailing label No. HB309363109, addressed to attorney for petitioner:

Robert B. Kennedy  
Kennedy & Kennedy  
400 Northpark Town Center  
1000 Abernathy Road, Suite 1250  
Atlanta, Georgia 30328

Signed this 27th day of October, 1994



\_\_\_\_\_  
Caroline Rule, Esq.